

Application No. 10/049,488
Amendment dated
Reply to Office Action of March 24, 2008

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Docket No.: 56925(71745)

REMARKS

Claim 9-19 and 21 are pending in the present application and are the subject of this Office Action. Support for the claims can be found throughout the specification including the Drawings and claims as filed originally. Claims 1-8, 20 and 22 have been canceled. No new matter has been added.

Applicants are submitting concurrently herewith a replacement sheet for Figure 1 which includes the phrase "Prior Art".

Applicants respectfully reserve the right to pursue any non-elected, withdrawn, canceled or otherwise unclaimed subject matter in one or more continuation, continuation-in-part, or divisional applications.

Reconsideration and withdrawal of the rejections of this application in view of the remarks and Declaration under 37 USC 1.132 submitted herewith, is respectfully requested, as the application is in condition for allowance.

Applicant now turns to comments made by the Examiner in this Office Action as follows.

OFFICE ACTION

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated.

The Examiner states, "See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. The replacement sheet filed October 11, 2006 does not include the phrase "Prior Art".".

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Applicants are submitting concurrently herewith a replacement sheet for Figure 1 which includes the phrase "Prior Art", thereby obviating the basis for objection.

2. Claims 9-19, 21 are rejected under 35 U.S.C. 103(a) as being obvious over Hughes 3,882,665.

The Examiner states, "Hughes teaches coating wire with plastic in an extrusion method, including a step of cooling the wire during the coating process (col. 7, lines 63-67). The wires are joined together in a strip 23 with apertures (sprockets) 24 (Figure 3). With respect to claim 22, plural plungers 19 on different axes inside different regions of second molded material

21 having a common core where walls 21 abut are adjacent to apertures 24. Note that in Figure 2, the wires 19 are shown protruding beyond the coatings 21. There are at least two reasons for coating the wires: a) to facilitate movement and adjustment of the wires (col. 1, lines 32-35) and b) to prevent corrosion by making the plastic very adherent to the wire (col. 2, lines 18-24). A primer is used to adhere the plastic tightly (col. 7, line 66- col. 8, line 5).

Hughes fails to teach that the wire (instant plunger) can slide in the coating (instant barrel).

It would have been obvious to omit the primer for adhering the plastic tightly to the wire if one were willing to forego the corrosion resistance of tight adherence of the plastic to the wire, for example, if one were drilling in a non-corrosive environment. See, e.g., MPEP 2144.04 IIA, reproduced below:

A. Omission of an Element and Its Function Is Obvious if the Function of the Element Is Not Desired

Ex parte Wu, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989) (Claims at issue were directed to a method for inhibiting corrosion on metal surfaces using a composition consisting of epoxy resin, petroleum sulfonate, and hydrocarbon diluent. The claims were rejected over a primary reference which disclosed an anticorrosion composition of epoxy resin, hydrocarbon diluent, and polybasic acid salts wherein said salts were taught to be beneficial when employed in a freshwater environment, in view of secondary references which clearly suggested the addition of petroleum sulfonate to corrosion inhibiting compositions. The Board affirmed the rejection, holding that it would have been obvious to omit the polybasic acid salts of the primary reference where the function attributed to such salt is not desired or required, such as in compositions for providing corrosion resistance in environments which do not encounter fresh water.). See also In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA

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1965) (Omission of additional framework and axle which served to increase the cargo carrying capacity of prior art mobile fluid carrying unit would have been obvious if this feature was not desired.); and In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (deleting a prior art switch member and thereby eliminating its function was an obvious expedient).

It is the examiner's position that omission of the primer would result in a poorly adhered coating that would be moveable relative to the wire, thus satisfying the limitations of both the method and apparatus claims. While Hughes does not use the device as a plunger type pipette, it is structurally capable of such use (when the invention of Hughes is modified as described), e.g., by moving the central or other wires. There is no claim directed to the method of use.”.

Applicants wish to draw the Examiner's attention to the 37 U.S.C. 1.132 Declaration submitted concurrently herewith by Dr. David Parnell. As Dr. Parnell points out, the principle of coating a metallic wire with a polymeric layer to provide electrical, mechanical, or chemical protection of the core is well established and is used in a number of industrial and consumer applications such as telephone wires, electrical power cables and the like.

The inventive step in '488 is to apply this technology, not for the protection of the wire, but to use the two components – the polymeric layer and the metallic core – as the barrel and piston of a dispensing or aspirating device.

The essential test of obviousness would appear to hinge on whether it is apparent that by using a means of protecting a flexible or rigid wire with a polymeric coating and then introducing relative motion between the two components, a positive displacement pipette device can be realized. The claimed advantage of this invention is that a piston/barrel combination so formed can be made where the barrel closely conforms to the piston without the more usual need to machine one component to match the other or the subsequent need to assemble the two parts either manually or automatically. The piston/barrel combination is formed in a single operation with the bore of the barrel exactly conforming to the outer diameter of the piston.

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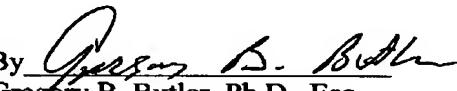
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In view of the above summary remarks and the details of the Declaration under 37 USC 1.132 by Dr David Parnell concurrently submitted herewith, Applicants submit that all claims are allowable and respectfully request early favorable action by the Examiner. Applicant's representative would like to discuss this case with the Examiner to learn if any outstanding issues remain after consideration of this Amendment. If the Examiner believes that a telephone conversation with Applicants' attorney would expedite prosecution of this application, the Examiner is cordially invited to call the undersigned attorney of record. Although it is not believed that any further fee is needed to consider this submission, the Office is hereby authorized to charge our deposit account 04-1105 should such fee be deemed necessary.

Dated: August 21, 2008

Respectfully submitted,

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